

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Satoko SHITAGAKI et al.)
Serial No.: 10/826,838)
 (Now Patent No. 7,601,435)) Confirmation No.: 1744
Filed: April 16, 2004)
For: Quinoxaline Derivative, and Organic)
 Semiconductor Device, Electric Field)
 Light Emitting Device, and Electronic)
 Device Which Have the Same)
Examiner: Jill M. Gray)
Art Unit: 1794)

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF THE
PATENT TERM ADJUSTMENT DETERMINATION

Sir:

This is a request for a reconsideration of the patent term adjustment determination in the above application.

The patent term adjustment in the Issue Notification of September 23, 2009 stated that the patent term will be extended by 348 days. However, Applicants respectfully submit that under 35 U.S.C. § 154(b)(2)(A) and 37 C.F.R. § 1.705(d) the patent term should be extended by an additional 268 days, for a total of 616 days.

Statement of the Facts

In the Issue Notification mailed September 23, 2009, the Office indicated that Applicants are entitled to a 348 day extension of the patent term. The application was filed on April 16, 2004. The Office mailed the first Office Action on October 5, 2006. Applicants responded to the Office Action on November 6, 2006. The Office mailed a non-final Office Action on February 7, 2007 to which Applicants filed a response on June 7, 2007. The Office Mailed a final Office Action on September 11, 2007 to which Applicants filed a response on December 11, 2007. The Office mailed an Advisory action on December 20, 2007 to which Applicants filed an RCE on January 10, 2008. The Office mailed a non-final Office Action on April 4, 2008 to which Applicants filed a response on July 7, 2008. The Office mailed a non-final Office Action on October 14, 2008 to which Applicants filed a response on February 17, 2009. The Office mailed a Notice of Allowance on May 14, 2009. The Applicants paid the issue fee on August 12, 2009, and the patent issued on October 13, 2009, as U.S. Patent No. 7,601,435.

Patent Term Adjustment Calculations

Under 37 C.F.R. § 1.702, the patent term adjustment for this application is the sum of the delays listed under § 1.702(a) ("Type A Delays") and § 1.702(b) ("Type B Delays"). Under 37 C.F.R. § 1.704, the patent term adjustment is then reduced by the number of days which are attributed to the Applicants' delay.

Type A Delays

Under § 1.702(a)(1), the patent term is extended by 476 days because the Office issued the first Office Action 476 days (same as above) after the 14 month time period from the day the application was filed. Thus, the total amount of Type A Delays is 476 days.

Type B Delays

Under § 1.702(b), the patent term is extended by 268 days. The Office issued the patent on October 13, 2009, which is 911 days after the 3 year time period from the day the application was filed. However, the Applicants filed a Request for Continued Examination on January 10, 2008. Under § 1.702(b)(1), Type B Delays do not include any time consumed by continued examination of the applicant under 35 U.S.C. 132(b). The number of days consumed by the RCE, i.e., the number of days between the date Applicants filed of the RCE and the issuance date of the patent, is 643 days. Thus, the total amount of Type B Delays is 268 days.

Type 1.704 Reduction

Under § 1.704, the patent term is reduced by 128 days due to delays by Applicants.

Overlap Determination

Under 35 U.S.C. § 154(b)(2)(A) and 37 C.F.R. § 1.703(f), the period of patent term adjustment, to the extent that the periods of delay “overlap,” should not exceed the actual number of days the issuance of the patent was delayed. Applicants submit that

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the Patent Office has misconstrued the meaning of "overlap" by calculating the patent term adjustment according to Type A Delays or Type B Delays, whichever is larger, but not for both Type A Delays and Type B Delays. Accordingly, the Office has calculated the patent term adjustment by using only the Type A Delays (476 days) minus the Type 1.704 Reduction (128 days) for a total of 348 days.

However, the term "overlap," as recognized in *Wyeth v. Dudas*, 580 F. Supp. 2d 138; 88 U.S.P.Q.2d 1538 (D.D.C. 2008), occurs when the periods of delay actually occur on the same calendar day. As stated by the District Court in *Wyeth*, if Congress had intended the statute to merely guarantee a 17 year patent term, measured from the issue date under prior law, it could have easily drafted the statute accordingly.

Applicants thus submit that under 35 U.S.C. § 154(b)(2)(A) and § 1.703(f), Applicants are entitled to the sum of both Type A Delays and Type B Delays (744 days), minus the *actual* overlap of any delays that occur on the same calendar day (0 days), and then further subtracting the Type 1.704 Reduction (128 days) for a total patent term extension of 616 days.

Applicants could not have raised this issue in an application for patent term adjustment because patent term adjustment cannot be calculated until the patent actually issues.

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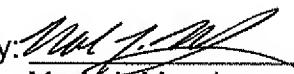
Conclusion

Therefore, it is respectfully submitted that under the correct interpretation of 35 U.S.C. § 154(b)(2)(A) and § 1.703(f), Applicants are entitled to a patent term adjustment of 616 days, and correction of the USPTO's patent term adjustment determination is requested. The fee for this request is paid herewith.

If any additional fee is required, authorization is hereby given to charge Deposit Account 50-1039.

Respectfully submitted,

Dated: December 10, 2007

By: 
Mark J. Murphy
Registration No. 34,225

COOK ALEX LTD.
200 West Adams Street, Suite 2850
Chicago, Illinois 60606
(312) 236-8500

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